

## II. REMARKS

The Examiner is requested to reconsider the application in view of the foregoing amendment and the following remarks.

The Amendment is being made not in response to the Office Action, so as to trigger potential file wrapper estoppel, but rather in response to the decision in *BMC Resources, Inc. v. Paymentech, L.P.*, Civ. No. 2006-1503 (Fed. Cir. Sept. 20, 2007) and to update claim language by removing certain more arcane phrasing. Generally, it is believed that the amendment adds no new matter.

It is respectfully submitted that it might be helpful to have a personal interview with the Examiner. This patent application was filed with code as an appendix, and a demonstration of the code operating on a computer may assist in the understanding of the claimed invention. A personal interview, prior to the next examination, is therefore requested.

Turning now to the Office Action, respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefor -- to the extent not rendered moot by the foregoing Amendment -- are traversed.

In the Office Action, at page 3, it is contended that "providing a website having identifier data that is encrypted" implies that the encrypted identifier is either displayed or at least viewable to a user at a web site... It is respectfully submitted that "having" does not imply or require "displaying" or that something be "viewable." Further, viewing encrypted data would be like reading gibberish. There is no contradiction. The Specification does support the claimed language, and should there be any doubt, the application was filed with operable code, which Applicant offers to demonstrate to the Examiner, to help ensure a common understanding of the invention, disclosure, and claim requirements.

The Office Action contends that there are "newly presented arguments" as to claim 1, but did not respond to any argument pertaining to Sec. 102 or Sec. 103, and thus did not

comply with Rule 104, particularly 104(a)(2), which requires, at least in part, as reproduced in part below:

...The reasons for any adverse action or any objection or requirement will be stated in an Office action and *such information or references will be given as may be useful in aiding the applicant... to judge the propriety of continuing the prosecution*

(italics added) and 104(c)(2) which requires, at least in part, as reproduced in part below:

...When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. *The pertinence of each reference, if not apparent, must be clearly explained, and each rejected claim specified.*

(italics added).

The Office did not respond to the 102 and 103 arguments in the appeal brief, and therefore the Office Action neither clearly provides a rational nor an explanation of the pertinence of the references as regards claim elements identified in the appeal brief as having not been shown in the cited art. Further, there has not been a response to Applicant's requests for information pursuant to 35 USC Sec. 132, and those requests set out in the appeal brief are incorporated here to solicit a response. Applicant especially requests "information" as to precisely what in Gabber corresponds to Applicant's claim terms: purchase, transaction, identifier data, and invisibly. However, all requests set out in the appeal brief solicit 132 information, and also pursuant to Rule 104, Applicant is entitled to this information.

#### **Paragraphs 4-5 of the Office Action**

In paragraphs 4-5 of the Office Action, claims 1, and 7-20 have been rejected pursuant to 35 U.S.C. Sec. 112, first paragraph. The Examiner contends that these claims fail to comply with the written description requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed,

was in possession of the claimed invention.

In response, the rejection is respectfully traversed. The Examiner has not made out a case that Applicant was not in possession of the claimed invention in view of the code filed with the application that is operable to carry out the claimed invention.

**Paragraphs 6-7 of the Office Action**

In paragraphs 6-7 of the Office Action, claims 8-14, 19 and 20 have been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that these claims are indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention, for reasons more particularly set out in the Office Action. In particular, the Examiner contends that "Claims 19 and 20 recite "including the step of encryption some of the data with private key to private key encryption. To one of ordinary skill, it is not clear the cryptographic method that the Applicant is referring to."

In response, the rejection is respectfully traversed. As regards claims 8-14, it is believed that the rejection is moot in view of the above amendment. As regards claims 19-20, evidence contradicting the Examiner's contention is provided in the Declaration of Professor Aviel Rubin. If the rejection is maintained, the Examiner is required to provide evidence to support his contention, such as his Declaration.

**Paragraphs 8-9 of the Office Action**

In paragraphs 8-9 of the Office Action, claims 1-7, 15, 16, and 18-20 have been rejected pursuant to 35 U.S.C. Sec. 102(b). The Examiner contends that these claims are anticipated by Gabber.

In response, the rejection is respectfully traversed as improper as set out above in the discussion of Rule 104: The Office Action is incomplete.

Further, as set out in the appeal brief, all art rejections are erroneous as premised on improper claim interpretation. Attention is respectfully drawn to the Final Rejection, Para. 9, pp.

7-8, where the Examiner contends that:

Gabber et al provide [sic] a method and system to allow a user to securely purchase goods and services over the Internet... Gift certificates, coupons, rebates and the like are all goods and services, therefore it would have been obvious... to procure, obtain, send and/or redeem certificates, coupons, etc. using the teachings of Gabber.

Now look to the present Office Action at Para. 9, page 8: "implementing the financial transaction (e.g., purchase..."

Attention is now respectfully drawn to independent claims 1-3, where a financial transaction is positively recited as separate and in addition to from a purchase. Gabber does not teach both a transaction and a purchase in the context of each of the claims as a whole. Thus, the Office Action has not shown that Gabber is the same as Applicant's claimed invention, and the same follows for the claims dependent on claims 1-3, namely 4-7, 15, 16, and 18-19 (20 having been incorporated into claim 19 and recycled into new claim 22).

#### **Claim 1**

Gabber also does not teach the claimed encrypted identifier data as claimed in claim 1. The passage cited in the Office Action does not meet all requirements of the claimed encrypted identifier data in the claim as a whole, as set out in the appeal brief and incorporated by reference here.

#### **Claim 2**

Gabber also does not teach the claimed reconciling a payment for the purchase invisibly to a purchaser by using the payment data communicated by the browser to implement a financial transaction....

Gabber teaches at Col. 6, lines 42-49 that "all users must send user specific information... e.g., credit card numbers... The Examiner has not explained how the payment data could be handled invisibly if the user had to enter the data. See Gabber at Col. 6, lines 65-67; Col. 8, lines 31-33. The Office Action citations in Gabber do not seem to pertain to using

payment data communicated by the browser to implement the financial transaction either. In any case, therefore (and further in view of the above-mentioned absence of any teaching of the claimed financial transaction in combination with the purchase), the Examiner has not made out a case of prima facie statutory anticipation of the claims based on the evidence of Gabber.

### Claim 3

With regard to claim 3 and its dependents, the rejection is respectfully traversed in view of the above-mentioned absence of any teaching of the claimed financial transaction in combination with the positively recited purchase and further at least because Gabber does not teach the claimed ...triggering communication of real-time payment... without customer intervention... as claimed. Gabber appears to teach that the triggering communication of real-time payment... WITH customer intervention... not without as claimed. That is, the customer intervenes in a triggering manner. However, the triggering at issue in Gabber is not in the context of Applicant's claim as a whole, or even in responding... to a computerized customer order to implement a financial transaction by triggering.... In any case, therefore (and further in view of the above-mentioned absence of any teaching of the claimed financial transaction in combination with the purchase), the Examiner has not made out a case of prima facie statutory anticipation of the claims based on the evidence of Gabber.

### Claim 4

This response incorporates the non-anticipation arguments set forth with regard to claim 3 upon which this claim depends, and supplements those arguments to the particular requirements of this claim. There additionally has been no showing that Gabber teaches that the claimed triggering is carried out by communicating over a proxy server. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

### Claim 5

This response incorporates the non-anticipation arguments set forth with regard to claim 3 upon which this claim depends, and supplements those arguments to the particular requirements of this claim. There has been no showing that Gabber teaches that the claimed triggering is carried out by communicating over an Internet-type network. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 6**

This response incorporates the non-anticipation arguments set forth with regard to claims 2-3 upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. There has been no showing that Gabber teaches that the claimed encrypting the data wherein the data further defines the payment data communicated by a browser... to implement a financial transaction (claim 2) or the real-time payment data... from a non-customer computer to a vendor computer.... (claim 3) Gabber of course does not teach the claimed financial transaction in combination with a purchase. Gabber's encrypting at Col. 9, line 25, is not of the data required in Applicant's claims. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 7**

This response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. The Examiner appears to rely on Gabber's "cookies", though in the Final Rejection, the Examiner concedes that "Gabber et al. does not specifically recite the use of attaching data for identifying a transaction to facilitate the transaction." The Examiner's admission is consistent with the fact that "cookies" do not meet the claim requirements as a whole: Gabber's cookies do not enable carrying out the financial

transaction. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 15**

This response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. The citations to Gabber concerning the claimed Receiving... the group consisting of a broker, agent, and middleman, the communication facilitating the financial transaction are insufficient at least because the claimed transaction has not been shown in Gabber. More so, the Examiner appears to be making some inference that such as NETCOM or AOL (Gabber Col. 6, line 52-54) is a teaching of a broker, agent, and middleman. This is an examiner inference rather than sufficient evidence under § 102. For example, there is no teaching that such as NETCOM is an agent or a broker or a middleman in facilitating the financial transaction. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 16**

This response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. The citations to Gabber concerning the claimed Receiving data indicating that a card account has been executed to carry out the financial transaction are insufficient at least because the claimed transaction has not been shown in Gabber. The Examiner seems to be contending that a card account is accessed in making a purchase under Gabber, but that is not the same as what Applicant claims. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 18**

This response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. The citations to Gabber concerning the claimed receiving data indicating that a bank account has been accessed to make a payment for the financial transaction are insufficient at least because the claimed transaction has not been shown in Gabber. The Examiner seems to be contending that a bank payment is being used in making a purchase under Gabber, but that is not the same as the claimed accessing a bank account to make a payment for the financial transaction. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 19**

This response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. Gabber does not teach private key to private key encryption of the particular data specified in the claims from which claim 19 depends. Therefore, and for all the other reasons pertaining to the claim upon which this claim depends, a prima-facie case of anticipation has not been shown.

#### **Claim 20**

As previously mentioned, the limitation of claim 20 was folded into claim 19, and the claim was recycled into new claim 22. The rejection is therefore moot.

#### **Paragraph 10 of the Office Action**

In paragraph 10 of the Office Action, claims 8-14, and 21 have been rejected pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious over Gabber, in view of Small.

In response, the rejection is respectfully traversed as improper as set out above in the



discussion of Rule 104 and Sec 132: The Office Action is incomplete.

Further, as set out above, all art rejections are erroneous as premised on improper claim interpretation.

Yet further, the obviousness contentions build on the deficiencies of the rejections for the independent claims, as set out above. Gabber does not teach both a transaction and a purchase in the context of each of the claims as a whole, and Small does not overcome this deficiency.

Thus, the Office Action has not shown that Applicant's claimed invention is prima facie obvious.

**Claims 8-14, and 21**

The rejection is improper under Rule 104 for failing to show correspondence between the particular claim requirements and the cited art teachings.

Further, this response incorporates the non-anticipation arguments set forth with regard to claims upon which this claim multiply depends, and supplements those arguments respectively to the particular requirements of this claim. Small does not teach the claimed attaching data identifying the gift to an Internet greeting card transmitted to enable carrying out the financial transaction. As no cited art teaches or enables this step, Gabber in view of Small cannot teach it.

The Examiner seeks to reason based on Venner that this is a mere provision of automatic means to replace manual means to accomplish the same result. Clearly, however, attaching data identifying the gift to an Internet greeting card transmitted to enable carrying out the financial transaction is not the same result as in Small, and the Examiner's contention that it is requires evidence. Also clearly, reconciling a payment for the purchase invisibly to a purchaser by using the payment data communicated by the browser to implement a financial transaction distinct from the purchase is not the same result as in Small, and the Examiner's contention that it is requires evidence. The Examiner's declaration is required to support his contentions that these are the same result.

Further, the fact that some things can be done invisibly does not mean that Applicant's claim requirement as a whole has been disclosed or suggested. There is no suggestion or teaching in Small of reconciling a payment for the purchase invisibly to a purchaser by using the payment data communicated by the browser to implement a financial transaction distinct from said purchase. Statutory prima facie obviousness has not been set out based on the cited evidence.

**Paragraph 12 of the Office Action**

In paragraph 12 of the Office Action, claims 9-14 have been rejected pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious over Gabber.

In response, the rejection is respectfully traversed as improper as set out above in the discussion of Rule 104 and Sec 132: The Office Action is incomplete.

Further, as set out above, all art rejections are erroneous as premised on improper claim interpretation.

Yet further, the obviousness contentions build on the deficiencies of the rejections for the independent claims, as set out above. Gabber does not teach both a transaction and a purchase in the context of each of the claims as a whole, and Small does not overcome this deficiency. Thus, the Office Action has not shown that Applicant's claimed invention is prima facie obvious.

The rejection is improper under Rule 104 for failing to show correspondence between the particular claim requirements and the cited art teachings.

Further, but for Applicant's claims, there has been no reason provided from the prior art to modify Gabber to reach the requirements of Applicant's claims. The rejection depends on the Examiner's contention as to what was obvious at the time of the invention, and thus the Examiner's declaration as to the obviousness of Applicant's claims, as precisely stated, is

hereby required.

**Paragraph 13 of the Office Action**

In paragraph 13 of the Office Action, claim 17 has been rejected pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious over Gabber, in view of Lineham.

In response, the rejection is respectfully traversed as improper as set out above in the discussion of Rule 104 and Sec 132: The Office Action is incomplete.

Further, as set out above, all art rejections are erroneous as premised on improper claim interpretation.

Yet further, the obviousness contentions build on the deficiencies of the rejections for the independent claims, as set out above. Gabber does not teach both a transaction and a purchase in the context of each of the claims as a whole, and Small does not overcome this deficiency. Thus, the Office Action has not shown that Applicant's claimed invention is prima facie obvious.

In addition, the construing of Gabber and Linehan to attempt to reach Applicant's claim requirements does not make sense when the claim limitations of the dependent claim are integrated with the limitations of the independent claims. That is, the data in claim 17 pertains in claim 3 to data from a non-customer computer which is contrary to the teaching of Linehan. The Examiner contended that the combination is to "communicate credit.. card data.. allow on line purchases." Final Rejection at Page 9; see also the Office Action at page 12. However, this is not the data set out in the independent claims from which claim 17 depends. The rejection carries forward a confusion as to the financial transaction vis-a-vis the purchase.

The reason to combine is improper at least because it is premised on incompatible interpretations of the meaning of transaction. Neither Gabber nor Linehan teach the transaction

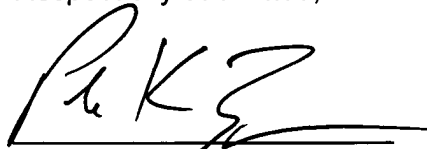
as required in Applicant's claims, so combining the teachings cannot lead to prima facie obviousness.

### Conclusion

In sum, the Office Action is improper and also fails to set out a prima facie case that the claims are anticipated by, or obvious in view of, the cited art of record. Favorable action is therefore requested, and again, Applicant suggests that a personal interview prior to the next examination could advance prosecution by ensuring a common understanding of this matter.

If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824. 0235, and if any extension of time is needed to reply or enter this filing that this shall be deemed a petition therefore. Please direct all communication to the undersigned at the address given below.

Respectfully submitted,



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